

REMARKS

Claims 1-21 are in the case. Claim 1 is the only independent claim. The examiner rejected claims 18-21 under 35 U.S.C. 112, stating that it is unclear whether the applicant is claiming a grill for cooking food workpieces or a transfer tool for the workpieces. The examiner also initially rejected claims 1-21 on prior art, under 35 U.S.C. 102 and 35 U.S.C. 103 in a detailed rejection stated in the office action.

With respect to the 35 U.S.C. 112 rejection, applicant is somewhat unsure why the examiner considered that a grill might be claimed because the preamble and the claims from which claims 18-21 depend all recite that the invention is a transfer tool. Claim 18 does make reference to a dimension of an associated grill and does recite a dimensional feature of the transfer tool in relation to a grill dimension. However, no grill structure is positively recited and therefore the grill structure is not a part of the invention. Although this is believed to make it clear that, as the examiner correctly assumed, only the tool is being claimed, applicant is willing to make an amendment but would appreciate any suggestion from the examiner.

With respect to the rejections under 35 U.S.C. 102 and 35 U.S.C. 103, applicant has amended claim 1, the only independent claim, and therefore has amended all of the claims. This amendment is believed to make the claims allowable without the need to argue the other claim limitations of the dependent claims which are now combined with the structural features of amended claim 1. Claim 1, and therefore the dependent claims, are allowable for the following reasons.

On the one hand, applicant's attorney feels confident that the examiner can see that none of the prior art is anywhere close to applicant's invention as illustrated and

could not function in the manner described by applicant. On the other hand, applicant's undersigned attorney understands that the examiner's responsibility is to compare the invention as claimed to the prior art. Therefore, the basis for the initial rejection is understood and the claims are amended to more particularly distinguish the invention as claimed from the prior art.

The difference is that the prior art has a sidewall that would prevent a structure like Hoffman's from being slid along the grill and under the workpieces (e.g. hamburger patties) to pick up a row of workpieces. That same sidewall would also prevent the workpieces from being slid from the bottom, workpiece-receiving panel onto another location on the grill. This operation is described in the application principally in paragraph [0029] and also other places, including paragraphs [0021] and [0024].

If a person attempted to use the Hoffman butler tray, or other prior art structures, to transport food workpieces, the prior art would require that the food workpieces be lifted in the conventional manner by a spatula, shoveled into the prior art tray, transported, and then lifted again with a spatula and shoveled onto the new grill location. Possibly, the prior art tray could be turned upside down to allow workpieces to fall onto the grill, but that would cause the workpieces to fall randomly and misaligned onto the grill. Therefore, the prior art would not have the utility or advantages of applicant's invention.

The structural difference is that, in the invention, the bottom, workpiece-receiving panel has an open, exposed, longitudinal edge so that food workpieces can be slid on and off the panel. This means that applicant's workpiece-receiving panel has no flange or

wall to block entry of a food workpiece onto that panel or to prevent it from being slid off.

Therefore, applicant has amended the claims to more particularly point out that feature. Specifically, applicant has further defined the workpiece-receiving panel as having "at least one exposed, longitudinal, open edge for slidably receiving workpieces". This is the edge 24 in applicant's figures. This means that the edge is exposed and open in the sense that there is no wall, flange or barrier that would prevent the panel of the tool from being slid along the grill and under the food workpieces to pick up a row of workpieces or would prevent the food workpieces from being slid from the bottom, workpiece-receiving panel onto another location on the grill.

Although this claim language was not in the original specification, it is not the introduction of new matter because this feature as stated in the claims is plainly disclosed in the drawings. This is especially true when the drawings are considered in combination with the description of the operation of applicant's tool. MPEP 608.04 states "In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. See MPEP § 608.01(1)." (emphasis added). MPEP 608.01(1) repeats that provision saying "In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it." Therefore, this new limitation is not new matter because it was clearly disclosed in the drawings and the drawings taken with the description of the operation in the original specification.

Applicant has also amended the specification to include reference to this claim limitation because MPEP 608.01(o) says:

"While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification" (emphasis added).

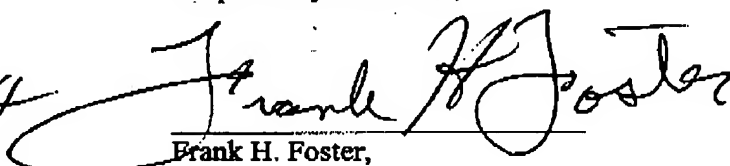
Applicant respectfully submits that it clearly would not have been obvious to modify a butler tray, picnic or egg basket, a trowel (used to smooth concrete or plaster) or a tool tray to conform to applicant's claimed structure in order to make a food cooking grill tool. The amendment to claim 1 distinguishes applicant's invention from the prior art and is not new matter.

Therefore, reconsideration and allowance are respectfully requested.

The Commissioner is authorized to charge Deposit Account No. 13-3393 for any insufficient fees under 37 CFR §§ 1.16 or 1.17, or credit any overpayment of fees.

Respectfully submitted,

10/14/04
Date of Signature



Frank H. Foster,
Reg. No. 24,560
KREMBLAS, FOSTER, PHILLIPS & POLLOCK
7632 Slate Ridge Blvd.
Reynoldsburg, OH 43068
Voice: 614/575-2100
Fax: 614/575-2149
email: ffoster@ohiopatent.com

Last printed 10/19/2004 9:07 AM
I:\client.docs\wendy's intl., inc\208 transfer tool\response1.doc